REMARKS

Claims 1, 3 through 8, 10 through 33, 35 through 45, 59, 60, 65 through 68 and 70 through 85 remain pending in this application. Claims 1, 3, 4, 6, 7, 8, 13, 17, 19, 23, 26, 28, 30, 36, 39, and 43 are amended herein. Claims 70 through 85 are added herein. Support for the amendments to the claims may be found, inter alia in the claims as originally filed. Further reconsideration of this application in view of the following remarks is respectfully requested.

Entry of the amendment filed August 26, 2003:

The Applicants acknowledge with appreciation the entry of the amendment filed August 26, 2003.

Response to Arguments:

The Applicants acknowledge with appreciation the consideration of the arguments filed August 26, 2003. Claims 1 and 28 have been amended to clarify the differences between them and the cited references. In particular, claim 1 now recites, in pertinent part,

"a processor responsive to the stored information data to output for display an interactive image derived from said video data and said information data."

While claim 28 now recites,

"responding to the stored information data by outputting for display an interactive image derived from said video data and said information data."

There is no teaching, disclosure or suggestion in Throckmorton of a processor responsive to stored information data to output for display an interactive image *derived* from video data *and* information data, as required by claims 1 and 28.

The Applicant is not insisting script data will never be stored in Throckmorton, contrary to the assertion in the Advisory action at paragraph 1 on page 2. Rather, no interactive image will ever be *derived* from either the control commands to be executed by microprocessor 38 or the script that is actually used by real-time trigger 76, to which

the final Office Action refers as information data. In fact, although associated data may be stored in Throckmorton, the *stored* data is never used to control real time trigger 76, which the Office Action analogizes to the processor of the present invention.

Throckmorton, rather, describes real time trigger 76 as accepting commands sent as part of the associated data to display a page of information without the user asking for it at column 7, lines 21 through 23. Real time trigger 76 thus acts on no stored commands, but rather only on commands arriving with the received signal. Stored data could *never* be used to control real time trigger 76, since if data were stored, it wouldn't be *real time*.

Throckmorton, in fact, describes real time as occurring during the process of program *reception*, at column 1, lines 64 and 65. If a received command were *stored*, it would not be available *during* the process of program reception, but only after the command has been received and stored. There would thus be a lag between its storage and retrieval, removing it from the realm of real time. This is significant because mocking real time is apparently one goal of Throckmorton, as described at column 1, lines 59 through 63.

Furthermore, as may be seen in Figs. 3 and 5 of Throckmorton, real-time trigger 76 is arranged in parallel with local data storage 80. Thus data going into local data storage 80 goes one way, while data used to drive real-time trigger 76 goes another. Since no line connects an input of real-time trigger 76 to local data storage 80 in either of Figs. 3 and 5, no stored information data will ever be used by real-time trigger 76 to output for display an interactive image *derived* from video data *and* information data, as required by claims 1 and 28.

Finally, the characterization of Throckmorton at paragraph 1 on page 3 of the Advisory action to the effect that,

> "Real time trigger 76, which is a software component included in the user's receiver equipment uses the script data in order to retrieve the appropriate associated data to displayed along with corresponding primary video

images, col. 7, lines 9-30."

is submitted respectfully to be incorrect. Throckmorton, rather describes real-time trigger 76 as being connected to communications manager 66 by one-way data path 78 at column 7, lines 13-15. Since real-time trigger 76 is connected to communications manager 66 by one-way data path 78, no retrieval of appropriate associated data is possible. Real-time trigger 76, rather, only accepts commands sent as part of the associated data to display a page of information without the user asking for it, as described at column 7, lines 21-23. Real-time trigger 76, then, is completely passive. Real-time trigger 76 can only react to commands sent to it, in real-time, as soon as they arrive. Storage of the commands is, consequently, inapposite.

The Advisory action asserts at paragraph 1 on page 3 that "associated data may be stored in the receiver prior to the image being displayed with its corresponding video image, col. 4, lines 25-27 & 60-63." Throckmorton, however, is referring to processor 4 at column 4, lines 25-27, and actually describes decoding associated data and supplying it to memory 5 for future use, rather than to a processor responsive to stored information data to output for display an interactive image derived from video data and information data, as required by claims 1 and 28. Similarly, Throckmorton is referring to synchronization of, for example, a data sheet with a television commercial at column 4, lines 60-63, rather than to a processor responsive to stored information data to output for display an interactive image derived from video data and information data, as required by claims 1 and 28.

Finally, the assertion to the effect that "(t)hus even if the information data is only momentarily held in a RAM, a buffer or some other memory unit, such an arrangement reads on the subject matter" at paragraph 1 on page 4 of the Advisory action is submitted to be inapposite. The Advisory action appears to be rearranging the components of Throckmorton to provide storage that is not otherwise disclosed, or even necessary for Throckmorton to function. The Applicants are not arguing that information

data is *never* stored, only that there is no teaching, disclosure or suggestion in Throckmorton of a processor *responsive* to stored information data to output for display an interactive image derived from video data and information data, as required by claims 1 and 28.

Claim Rejections - 35 U.S.C. § 103:

The final Office Action rejects claims 1, 3, 4, 6 through 8, 10 through 14, 16 through 30, 32, 33, 35 through 37, 39 through 45, 66 and 68 under 35 U.S.C. § 103 as unpatentable over Throckmorton et al., US 5,818,441 in view of Green et al., US 5,664,110 and Aker (The Macintosh Companion). The rejection is again traversed. Withdrawal of the rejection is again respectfully requested.

It is submitted that no processor responsive to stored information data to output for display an interactive image derived from video data and information data, as recited in claims 1 nor 28, is disclosed in either Throckmorton, Green or Aker. Since neither Throckmorton, Green or Aker disclose a processor responsive to stored information data to output for display an interactive image derived from video data and information data, their combination cannot, either.

Furthermore, disparate references, no matter how notoriously well known they may or may not have been at the time of the invention, does not rise to the level of proof need for a rejection under 35 U.S.C. § 103(a). 35 U.S.C. § 103(a) and the M.P.E.P. §706.02(j)(D), rather, require the claimed *combination* of elements to have been obvious to persons of ordinary skill in the art at the time the invention was made, not just any particular individual element.

Merely pointing to descriptions of one or another of the individual elements, such as, for example, activating a modem using a GUI, does not render the claimed *combination* of elements obvious. Sand and ice cream, for example, may be notoriously well known to those who have visited Ocean City, Maryland, but that does not imply that it would ever be obvious to combine them.

"It is insufficient that the prior art [discloses] the components . . . either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor." *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990), *cert. denied*, 498 U.S. 920 (1990).

"When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." *In re Rouffet*, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998); see also M.P.E.P. § 2143.01. Virtually all inventions are combinations of old elements. *See In re Rouffet*, 47 USPQ2d at 1457. If identification of each claimed element in the prior art were sufficient to negate patentability, the Examiner could use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. *See Id.* To prevent the use of hindsight based on the teachings of the patent application, the Examiner must show a motivation to combine the references in the manner suggested. *See Id.* at 1457-1458.

The final Office Action asserts at pages 3 that "it was well known in the art for a user of a network data terminal to utilize a GUI image in order to activate a modem to establish communication with a remote site." The whole point of a GUI, however, is to insulate a user from the internal workings of a computer or other device. GUI's are for people who have no interest in what goes on behind a screen. It is submitted respectfully that interpreting someone's manipulating a GUI as intending to activate a modem is a bit of a reach. There's no reason to think that a user shielded from a computer by a GUI would have any opinion at all about how or why the pretty pictures came to be. The reason the final Office Action needs Green is because the element of activating a modem recited in claims 1 and 28 is lacking from Throckmorton. The final Office Action has still supplied no motivation for the *proposed* modification of Throckmorton. The Applicants request respectfully a showing of some motivation in the

reference as to why a user would want to activate a *modem*.

With respect to Aker, merely discussing what Aker may describe *separately* does not meet the requirements of 35 U.S.C. § 103(a) and the M.P.E.P. §706.02(j)(D) with respect to a showing that the *combination* of elements would have been obvious to persons of ordinary skill in the art at the time the invention was made.

The final Office Action points out at page 5 that Cina was provided pursuant to applicants request. The final Office Action used Official Notice to meet one of the claimed elements as part of the rejection. Cina, however, was not cited in the rejection at all. Whether the Applicants had to ask for evidence to support a rejection is submitted to be of no consequence. If a piece of evidence is being used in support of a rejection, it is submitted to belong in the rejection.

Furthermore, the Applicants are entitled to more than a showing that an individual element such as size or resolution may have been known *separately* a the time the invention was made. 35 U.S.C. § 103(a) and the M.P.E.P. §706.02(j)(D), requires a showing that such knowledge would have led persons of ordinary skill in the art at the time the invention was made to view the *combination* of claimed elements to have been obvious.

The Applicants must reiterate their request for evidence to support the taking of Official Notice that the combination of elements would have been obvious to persons of ordinary skill in the art at the time the invention was made. Otherwise, the Official Notice is traversed.

As discussed above with respect to Aker, merely discussing what Cina may describe does not meet the requirements of 35 U.S.C. § 103(a) and the M.P.E.P. §706.02(j)(D) with respect to a showing that the *combination* of elements would have been obvious to persons of ordinary skill in the art at the time the invention was made.

Finally, with respect to the Nemirosky, Schutte and Chen references, the final Office Action used Official Notice to meet one of the claimed elements as part of the

rejection. Neither Nemirosky, Schutte nor Chen, however, were cited in the rejections. Furthermore, as discussed above with respect to Aker, merely discussing what Nemirosky, Schutte or Chen may describe does not meet the requirements of 35 U.S.C. § 103(a) and the M.P.E.P. §706.02(j)(D) with respect to a showing that the *combination* of elements would have been obvious to persons of ordinary skill in the art at the time the invention was made.

The Applicants must reiterate their request for evidence to support the taking of Official Notice that the combination of elements would have been obvious to persons of ordinary skill in the art at the time the invention was made. Otherwise, the Official Notice is traversed.

Furthermore, there is no disclosure of a processor responsive to stored information data to output for display an interactive image *derived* from video data and information data, as required by claims 1 and 28. Rather, the "primary data" of Throckmorton is rendered and displayed immediately and quite separately from the "associated data". The processing of the image data is not responsive to the stored associated data in Throckmorton.

This results in a vital difference between the disclosure of Throckmorton and the claimed invention. Throckmorton simply relates to the provision of separate "associated data" relating to "primary data". For example, one can imagine this being displayed as two separate windows on a PC monitor or using a PC to deal with the "associated data" in combination with a television receiving the "primary data" as a normal television broadcast.

In contrast, the present invention displays an interactive image derived from video data and information data. For example, in the case of an electronic program guide, the displayed interactive image may include the video data.

This should not be confused with the display of "associated data" in Throckmorton at a time associated with the receipt of the "primary data". This is the

display of "associated data" dependent on the "primary data", not the display of data derived from image data and the information data in response to the information data, as required by the claimed invention.

Furthermore, the final Office Action identifies the claimed image data and information data as being included in the "associated data" of Throckmorton. In this case, the Applicants understand that the claimed decoder for separating the image data and information data would, in Throckmorton, be the communications manager 66. Thus, while the final Office Action points out that the associated data of Throckmorton may be stored in local data storage 80 of Throckmorton, it is clear that the commands included in the associated data are dealt with by the real time trigger 76. These commands are not therefore stored.

Throckmorton therefore lacks a processor responsive to stored information data to output for display an interactive image derived from video data and information data, as required by Claim 1. Furthermore, these features are not taught in either Green or Aker.

As can appreciated from the specific embodiments of the invention described in the application, the generation of an interactive image in response to stored information data allows interactive image to be generated using stored templates, software and such like along with video data received in television signal for example. In contrast, the commands of Throckmorton are concerned with synchronizing the display of information with the arrival time of broadcast television signals.

The Applicants request respectfully some evidence be provided to support the assertion in the final Office Action at page 8 to the effect that 'it was well known in the art to for (sic) a user of a network data terminal device to utilize a GUI image in order to activate a modem and establish communication with a remote site', and hence that it would have been obvious to modify Throckmorton. In the meanwhile, the assertion is traversed.

Green neither teaches, discloses, nor suggests a processor responsive to stored information data to output for display an interactive image derived from video data and information data, as recited in claims 1 nor 28.

Aker neither teaches, discloses, nor suggests a processor responsive to stored information data to output for display an interactive image derived from video data and information data, as recited in claims 1 nor 28, either. Since neither Throckmorton, Green, nor Aker describe a processor responsive to stored information data to output for display an interactive image derived from video data and information data separately, their combination cannot, either.

The Applicants request some motivation or suggestion to combine the teachings of Throckmorton, Green, and Aker, as required by 35 U.S.C. § 103(a) and the M.P.E.P. §706.02(j)(D), beyond the simple assertion that one or another of the elements may have been known in the art, or notoriously well known, or obvious.

The Applicants also request respectfully some evidence to support the taking of official notice at page 11 to the effect that it was well known in the art to generate image data with a specific size or resolution, and hence that it would have been obvious to modify Throckmorton. In the meanwhile, the assertion is traversed.

Furthermore, the Applicants request respectfully some evidence to support the taking of official notice at page 12, to the effect that it was well known in the art to issue credit cards, and hence that it would have been obvious to modify Throckmorton. In the meanwhile, the assertion is traversed.

Finally, M.P.E.P. § 2143.01 prohibits proposing a modification that renders a reference unsatisfactory for its intended use. The purpose intended for Throckmorton is "creating and transmitting associated data which provides the appearance of an interactive connection to secondary sources of information", as described at column 1, lines 10 through 12. Throckmorton believed that two-way communication would be too expensive, as described at column 1, lines 57 and 58. Throckmorton proposed therefor

offering a consumer a *perception* of receiving interactive data, as described at column 2, lines 58 through 59, without otherwise tying up bandwidth.

If Throckmorton were modified as proposed in the final Office Action, however, the connection established by the modem would hog the bandwidth Throckmorton is seeking to preserve. The modification of Throckmorton proposed in the final Office Action would thus render Throckmorton unsuitable for its intended purpose, i.e. offering a consumer a perception of interactivity *without* using extra bandwidth, in violation of M.P.E.P. § 2143.01.

Accordingly, claims 1 and 28 and their dependent claims are believed to be patentable over Throckmorton in view of Green and Aker. Withdrawal of the rejection of claims 1 and 28 is earnestly solicited.

Claims 5, 15, 31, 38, 65 and 67 are rejected under 35 U.S.C. § 103(a) as unpatentable over Throckmorton in view of Green and Aker, and further in view of Hendricks, WO 94/14284. The rejection is traversed. Withdrawal of the rejection is respectfully requested.

Claims 5, 15, 31, 38, 65 and 67 depend from one of claims 1 or 28. Neither Throckmorton, Green, nor Aker describe responding to stored information data to output for display an interactive image derived from video data and information data as discussed above with respect to claims 1 and 28. It is respectfully submitted that Hendricks does not, either.

Since neither Throckmorton, Green, Aker nor Hendricks disclose responding to stored information data to output for display an interactive image derived from video data and information data separately, their combination cannot, either. Claims 5, 15, 31, 38, 65 and 67 are thus submitted to be allowable. Withdrawal of the rejection of claims 5, 15, 31, 38, 65 and 67 is earnestly solicited.

Claims 59 and 60 are rejected under 35 U.S.C. § 103(a) as unpatentable over Throckmorton in view of Green and Aker, and further in view of Vlahos, US 5,907,315.

The rejection is traversed. Withdrawal of the rejection is respectfully requested.

Claims 59 and 60 depend from claim 1. Neither Throckmorton, Green, nor Aker describe a processor responsive to stored information data to output for display an interactive image derived from video data and information data, as discussed above with respect to claim 1. It is respectfully submitted that Vlahos does not, either.

Since neither Throckmorton, Green, Aker nor Vlahos disclose a processor responsive to stored information data to output for display an interactive image derived from video data and information data separately, their combination cannot, either. Claims 59 and 60 are thus submitted to be allowable. Withdrawal of the rejection of claims 59 and 60 is earnestly solicited.

New claims:

Claim 70 recites, in pertinent part,

"the processor being responsive to received viewer command signals to cause the modem to transmit data to and receive on-line data from a remote site for on-line interaction via the interactive image between the viewer and the remote site and to output for display a further interactive image derived from said image data, said information data and said received on-line data."

There is no teaching, disclosure or suggestion in any cited reference of a processor responsive to received viewer command signals to cause a modem to transmit data to and receive on-line data from a remote site for on-line interaction via the interactive image between the viewer and the remote site and to output for display a further interactive image derived from image data, information data and received on-line data, as recited in claim 70. Claim 70 is submitted to be allowable. Claims 71 through 78 depend from claim 70 and add further distinguishing elements. Claims 71 through 78 are thus submitted to be allowable. Claim 79 depends from claim 1 and adds further distinguishing elements. Claim 79 is thus submitted to be allowable.

Claim 80 recites, in pertinent part,

"responding to said command signals to vary the interactive image and to cause the modem to transmit data to and receive on-line data from a remote site for on-line interaction via the interactive image between the viewer and the remote site and to output for display a further interactive image derived from said image data, said information data and said received on-line data."

There is no teaching, disclosure or suggestion in any cited reference of responding to command signals to vary an interactive image and to cause a modem to transmit data to and receive on-line data from a remote site for on-line interaction via the interactive image between a viewer and the remote site and to output for display a further interactive image derived from image data, information data and received on-line data, as recited in claim 80. Claim 80 is submitted to be allowable. Claims 81 through 85 depend from claim 80 and add further distinguishing elements. Claims 81 through 85 are thus submitted to be allowable.

Conclusion:

In view of the above amendments and remarks, it is believed that the claims satisfy the provisions of the patent statutes and are patentable over the prior art. Reconsideration and early notice of allowance are requested.

Respectfully submitted,

By

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